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09/603,303	06/23/2000	Scott Lorenz	5053-36000	1772

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EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/603,303

Applicant(s)

LORENZ, SCOTT

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 12 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 and 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendment filed 12 April 2003. Claims 1-27 are pending. Claims 1, 9, and 22 have been amended. Claims 23-27 are new.

### ***Claim Rejections - 35 USC § 101***

2. The rejections of claims 16-22 under 35 USC 101 are hereby withdrawn due to the amendment filed 12 April 2003. However, it is noted that the recitation of "program instructions... computer-executable to implement" in claim 16 is interpreted to mean the program instructions are "embodied on a computer."

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

Claim 23, line 14, recites "wherein the first set of program instructions comprises a web server." It is unclear to the Examiner how a web server, which is a form of computer hardware, can be comprised of program instructions. Does the

Applicant mean that the program instructions are stored in memory on a web server? Applicant is requested to clarify what the structural cooperative relationship is between the web server and the program instructions.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 6-7, 9-10, 12-14, 16-17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al. (5,950,169), for substantially the same reasons given in the previous Office Action (see paper number 8), and further in view of Burchetta et al. (6,330,551).

(A) Claim 1 has been amended to include the recitation of "wherein the first set of program instructions comprise a sequence of steps established dynamically in real time" and "wherein the second set of program instructions comprise a sequence of steps established dynamically in real time."

Borghesi fails to disclose the establishment of program instructions dynamically. However, Borghesi discloses a system for managing insurance claim processing comprising:

(a) a communication server for insurance claim management comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

transmitting, from a remote computer, a predetermined amount of data related to calculate a total loss valuation to the server, wherein the data is input by a user through a user interface (col. 21 lines 29-35 and col. 23 lines 17-34);

(b) at least one remote computer terminal comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

inputting and outputting data pertaining to an insurance claim through a graphical user interface (col. 23 lines 17-34); and

sending an insurance claim data file over a network to the communication server, wherein the data file contains data on the insured, data on a claim, and data on satisfying a claim (col. 20 line 55 to col. 21 line 17 and col. 22 lines 19-40).

Burchetta discloses standard PC computer including a computer program communicating over the Internet with a web server for creating web pages, wherein the computer program implementing the computerized dispute resolution system of claims begins by a user opening a web browser and accessing the system website, wherein

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the user is prompted by a menu with a series of options (col. 1 lines 39-50, col. 2 lines 40-55, col. 5 line 20 to col. 6 line 10, col. 8 lines 1-30, col. 10 line 13 to col. 12 line 45). Furthermore, Burchetta includes a real time system for the entry of claims and settlement offers (col. 5 lines 20-40), wherein the computer program provides for logging into the system to edit or view cases/claims by entering a username and corresponding password, wherein if the username and password do not match those known in the system, the user is shown an error screen with the option to try again, wherein if the user has logged in before with the same computer, his or her username may already be entered into the system, and the server which distributes the web pages checks the user's password against the username (col. 1 lines 39-50, col. 2 lines 40-55, col. 5 line 20 to col. 6 line 10, col. 8 lines 1-30, col. 10 line 13 to col. 12 line 45, col. 18 line 15 to col. 19 line 27) (reads on "'wherein the first set of program instructions comprise a sequence of steps established dynamically in real time" and "wherein the second set of program instructions comprise a sequence of steps established dynamically in real time.") Burchetta includes upon logging into the system, for the user add or edit a claim, wherein the add/edit screen includes a "submit" button, which send the information entered on the website to be checked for formatting, wherein the screen points out missing or improperly formatted text, or returns the text for verification, and wherein if the text is accepted, the data is sent to the database for entry as an addition or update (col. 1 lines 39-50, col. 2 lines 40-55, col. 5 line 20 to col. 6 line 10, col. 8 lines 1-30, col. 10 line 13 to col. 12 line 45, col. 18 line 15 to col. 19 line 27) (reads on "'wherein the first set of program instructions comprise a sequence of steps established

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dynamically in real time” and “wherein the second set of program instructions comprise a sequence of steps established dynamically in real time.”) The functions of the aforementioned features of Burchetta’s system are implemented using computer program modules, such as Javascript objects or Cold Fusion Script (col. 10 line 13 to col. 12 line 45, col. 18 line 15 to col. 19 line 27).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the dynamic features of Burchetta within the system of Borghesi with the motivation of providing a reliable and scalable platform for use in a claims processing system to give users easy and effective access to information and resources (Burchetta; col. 18 lines 40-55) and providing users with the ability to settle claims easily, effectively, and inexpensively (Burchetta; col. 1 lines 30-36).

(B) Claims 2, 6-7, 10, 12-14, 17, and 19-21 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 8, section 5, pages 4-7).

(C) The amendments to claims 9 and 16 reflect the same changes made to claim 1, discussed above, and are therefore rejected for the same reasons given above for claim 1 in addition to the rejections made for claims 9 and 22 in the prior Office Action (paper number 8, section 5, pages 4-7).

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7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al. (5,950,169) as applied to claim 1, and further in view of McKee et al. (6,272,482) and Walker et al. (6,119,093), for substantially the same reasons given in the previous Office Action (see paper number 8), and further in view of Burchetta et al. (6,330,551).

(A) Claims 3 and 4 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 8, section 7, pages 7-9).

8. Claims 5, 8, 11, 15, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al. (5,950,169) as applied to claims 1, 9, and 16, for substantially the same reasons given in the previous Office Action (see paper number 8), and further in view of Burchetta et al. (6,330,551).

(A) Claims 5, 8, 11, 15, 18, and 22 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 8, section 8, pages 9-10).

9. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al. (5,950,169) in view of Burchetta et al. (6,330,551).



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(A) As per claim 23, Borghesi discloses Borghesi discloses a system for managing insurance claim processing comprising:

(a) a communication server for insurance claim management comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

transmitting, from a remote computer, a predetermined amount of data related to calculate a total loss valuation to the server, wherein the data is input by a user through a user interface (col. 21 lines 29-35 and col. 23 lines 17-34);

(b) at least one remote computer terminal comprising a processor coupled to memory, wherein the memory is embodied as a mass storage device and storing a program constructed using known software tools and languages, wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

inputting and outputting data pertaining to an insurance claim through a graphical user interface (col. 23 lines 17-34); and

sending an insurance claim data file over a network to the communication server, wherein the data file contains data on the insured, data on a claim, and data on satisfying a claim (col. 20 line 55 to col. 21 line 17 and col. 22 lines 19-40).

Borghesi fails to expressly disclose a first set of program instructions comprising a web server, a second set of program instructions comprising a web browser, and wherein the web browser is operable to generate web pages dynamically.

Burchetta discloses a computerized system for automated dispute resolutions of claims, wherein the system uses a web server, such as Microsoft® Internet Information Server 4.0, for providing the creation of web pages and the publication of information to the world wide web, wherein the web server uses a computer program representing a distributed database application written in a Markup language such as ColdFusion Markup Language and HTML, wherein the web server uses ColdFusion server extensions and Microsoft's SQL server to allow users to access via a web browser a database cases/claims(col. 1 lines 39-50, col. 2 lines 40-55, col. 9 line 52 to col. 10 line 30, col. 18 line 62 to col. 19 line 27), wherein a standard PC computer communicates with the web server through the Internet and accesses the system website through a web browser, wherein the system prompts the user at each step of the claims process and provides automated, on-demand help if needed, and wherein the screens on the standard PC computer are created by suitable computer programs written in Standard Generalized Mark-up Language such as ColdFusion script (col. 2 lines 40-55, col. 8 lines 1-10, col. 10 lines 10-30, col. 12 lines 40-55, col. 18 line 62 to col. 19 line 27).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the dynamic features of Burchetta within the system of Borghesi with the motivation of providing a reliable and scalable platform for use in a claims processing system to give users easy and effective access to information and

resources (Burchetta; col. 18 lines 40-55), providing interactive processing to allow attorneys and claims adjusters to access the system via a standard web browser (Burchetta; col. 9 lines 52-65), and providing users with the ability to settle claims easily, effectively, and inexpensively (Burchetta; col. 1 lines 30-36).

(B) As per claims 24-25, Burchetta discloses a web server publishing web pages to display information on the world wide web to a standard PC computer via the Internet, wherein the web pages are displayed through a web browser on the standard PC computer and include prompting the user to enter an amount for each claim (reads on "insurance claim assessment questions") (col. 2 lines 41-55, col. 9 lines 22-32, col. 10 lines 12-30, col. 11 lines 2-63, col. 18 line 62 to col. 19 line 27). The remainder of claim 24 repeats the same limitations as claim 23, and is therefore rejected for the same reasons given above, and incorporated herein. The motivation for combining Burchetta within Borghesi is given above in claim 23, and incorporated herein.

(C) As per claim 26, Borghesi discloses the server and remote computer terminals format and send data over a network using TCP/IP (Fig. 2 and col. 11 lines 44-52).

(D) As per claim 27, Borghesi discloses at least one remote computer and a network connecting the computers to a server (Fig. 2 and col. 20 lines 33-50). The remainder of claim 27 repeats the same limitations of claim 23, specifically with regards to the steps

performed using the apparatus of claims 23, and therefore claim 27 is rejected for the same reasons given above for claim 23, and incorporated herein.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments filed 12 April 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 12 April 2003.

(A) At pages 10-14 of the 12 April 2003 response, Applicant argues that the newly added features in the 12 April 2003 amendment are not taught or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 12 April 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Borghesi, Burchetta, McKee, and/or Walker based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 8), and incorporated herein. One cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223

USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it seen that the Examiner's combination of references is supported by the prior art of record. It is respectfully submitted that explanation based on the logic and scientific

reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. And Inter., 4/22/93).

As such, is respectfully submitted that Applicant appears to view the applied references, separately and in a vacuum, without considering the knowledge of average skill in the art.

In addition, the Examiner is concerned that, aside from merely alleging that certain claimed features are not obvious from the collective teachings of Borghesi, Burchetta, McKee, and/or Walker, essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out HOW the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

### **Conclusion**

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12. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a method and system for submitting and tracking insurance claims via the internet (US 2001/0037224 A1), automated claim processing and attorney referral and selection (US 2001/0041993 A1), automated insurance system and method (US 2002/0002475 A1), system and method of administering, tracking, and managing of claims processing (US 2002/0035488 A1), system and associated methods for providing claimant services with increased quality assurance (US 2002/0035491 A1), and insurance claim filing system and method (US 2002/0120473 A1).

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

15. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 746-8374	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).


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June 5, 2003

  
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